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IN THE

Supreme Court of the United States

NO. 680

OCTOBER TERM, 1957

THE COLD METAL PRODUCTS COMPANY,
Petitioner,

v.

CRUCIBLE STEEL COMPANY OF AMERICA,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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To the Honorable Chief Justice and the Associate Justices of the Supreme Court of the United States:

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit, entered in the above entitled action on August 9, 1957 (rehearing denied September 25, 1957).

THE OPINIONS BELOW.

The opinion of the District Court is reported at 147 F. Supp. 25 and is printed in Cold Metal's appendix filed in the Court of Appeals (P. App. 229a-246a), nine copies

of which have been filed herein.* The opinion of the Court of Appeals is reported at 247 F. 2d 241 and is printed in the appendix hereto, *infra,* pages 1a to 18a. The petition for rehearing filed by Cold Metal was denied without opinion.

JURISDICTION.

The judgment of the Court of Appeals (App., *infra,* p. 19a) was entered on August 9, 1957 and a petition for rehearing was denied on September 25, 1957. The jurisdiction of this Court is invoked under 28 U.S.C., Section 1254(1).

QUESTIONS PRESENTED.

I.

Did the Court of Appeals (a) in rejecting and reversing express findings of the District Court on controlling factual matters, which are fully supported by substantial evidence, namely, the testimony of witnesses for both parties, and (b) in rejecting a positive admission of respondent, violate and fail to conform to Rule 52(a) of the Federal Rules of Civil Procedure, which states:

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* Petitioner, The Cold Metal Products Company, will be referred to herein as "Cold Metal" and respondent, Crucible Steel Company of America, as "Crucible."

Cold Metal's Appendix filed in the Court of Appeals will be referred to as P. App. ——.

Cold Metal's Supplemental Appendix filed in the Court of Appeals will be referred to as P. Supp. App. ——.

Crucible's Appendix filed in the Court of Appeals will be referred to as R. App. ——.

Nine copies of each have been filed herein.

"Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

II.

Is the decision of the Court of Appeals, in which it determined controlling factual matters contrary to the express findings of the District Court and all the pertinent evidence and admissions, in conflict with the decisions of this Court in *Graver Tank & Mfg. Co., Inc. et al. v. Linde Air Products Co.,* (1949) 336 U.S. 271, 274-275, and 339 U.S. 605, 609-10?

III.

Is the decision of the Court of Appeals construing the disclosure of a patent contrary to the testimony of the witnesses for both parties as to the meaning of that disclosure to those skilled in the art in conflict with this Court's decisions in *Carnegie Steel Company v. Cambria Iron Company,* (1902) 185 U.S. 403, 437; *Minerals Separation, Limited, et al. v. Hyde,* (1916) 242 U.S. 261, 270-71, and others, holding that a patent disclosure is addressed to those skilled in the art?

RULE INVOLVED.

Rule 52(a) of the Federal Rules of Civil Procedure is involved. It is printed in the appendix hereto, *infra*, p. 20a.

STATEMENT.

A. The Nature of the Case.

On September 30, 1946, Cold Metal granted to Crucible a license (P. App. 80a) under several patents directed to reversing hot strip mills for the production of hot rolled steel strip. In 1948 and early 1949, Crucible, under its license, installed a reversing hot strip mill and placed it in commercial operation about April 1, 1949. Crucible paid royalties (but not all which were due) under its license agreement from April 1, 1949 to November 30, 1951.

In October and November of 1951, after the three earliest patents included in the license had expired, Crucible made certain modifications in its mill which it contended took the mill outside the scope of the licensed patents remaining in force. Cold Metal inspected Crucible's modified mill, found it still within three of the licensed patents, and brought suit for royalties due under the contract for operation of that modified mill and also for additional royalties due on the original mill.

On April 1, 1953, while the litigation on the contract was pending, Crucible canceled the agreement pursuant to its terms and later filed a supplemental counterclaim seeking a declaratory judgment that the three patents which Cold Metal had charged were being infringed were invalid and not infringed by Crucible in its operation of the mill from and after April 1, 1953.

The case before the District Court and the Court below thus presented the following issues:

(a) Whether the modified Crucible mill and its operation, during the period from November 30,

1951 to April 1, 1953, came within the scope of any claim of three of the licensed patents, *viz.* 2,214,107, 2,072,122 and 2,087,065.*

(b) Whether the three patents were valid and infringed by the modified mill and its operation after April 1, 1953.

The District Court, on the basis of substantial evidence, held that, during the existence of the license, the Crucible modified mill came within the scope of each of the three licensed patents. As to operations after cancellation of the license agreement, the District Court held patents '065 and '107 invalid and, therefore, not infringed; but it held certain claims of the '122 patent both valid and infringed. It also gave judgment for the additional royalties due under the license agreement for the operation of the original mill.

The Court below, despite substantial evidence supporting the District Court's findings, held that Crucible's operation of its modified mill, during the period from November 30, 1951 to April 1, 1953 (while the license was still in force), was not within the scope of any of the three patents, and further held that, as to the period subsequent to April 1, 1953, the three patents were invalid and not infringed.

This petition for *certiorari* challenges the holdings of the Court below that the Montgomery '107 and '122 patents did not cover the operation of the modified Crucible mill while the license agreement was in force and also the decision of the Court below holding invalid

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* These patents are referred to hereinafter by the last three digits, *e.g.* '107, '122 and '065.

and not infringed Claims 6, 18 and 19 of the Montgomery '122 patent. It is these holdings which are squarely in conflict with Rule 52(a) and applicable decisions of this Court.

B. The Subject-Matter of the Patents.

The patents under which the license was granted relate to a reversing hot strip mill used for the hot rolling of relatively thick ingots and slabs into relatively thin gauge steel strip in long lengths. A typical steel ingot is fifteen inches high, twenty or twenty-two inches wide, fifty-four inches long, and weighs up to 24,000 pounds. A typical product of the mill is hot steel strip .080 inch thick and eighteen to fifty inches wide.

Other mills are used to produce hot steel strip, notably multi-stand 4-high continuous mills. Such mills, however, are huge and tremendously expensive and, therefore, can be built and operated only by the few largest steel companies in the country, not only because of their high initial cost but also because of the problem of supplying such a mill with material to keep it running. The reversing hot mill was invented by Cold Metal's engineers to meet the requirements of small steel companies who could not afford a large continuous mill but who, nevertheless, needed a source of hot steel strip.

Crucible was and is such a small company. It did not have the capacity to supply a continuous mill and keep it going and it could not afford the cost of such a mill, which was in the order of 35 to 40 million dollars, whereas the reversing hot strip mill which it installed under license cost only 6½ million dollars (App. 59a-

62a). The mill thus enabled Crucible to manufacture its own hot strip rather than buy it from others or send its slabs out and have them rolled to hot strip by others. The mill has many substantial advantages over other mills and Crucible enjoyed those advantages (P. App. 62a).

The licensed patents have enjoyed considerable commercial success. A number of the mills have been built and a number of licenses have been granted, both in this country and abroad (P. App. 33a).

Cold Metal built the first reversing hot strip mill at the Brier Hill plant of the Youngstown Sheet & Tube Company as an experiment to determine the feasibility of rolling hot steel strip on a reversing mill. That mill served to demonstrate the requirements for and the commercial practicability of this new mill.

That experimental mill is shown in Steckel patent No. 1,977,214 (P. App. 197a). Referring to Figures 2 and 3 of the patent, it will be seen that the mill comprises a roll table on each side of a reversing mill having working rolls 54 between which the steel passes and is reduced. The material is rolled back and forth through the mill on the roll tables until it is thin enough to coil, whereupon, as the material comes from one side of the mill or the other, a "kick-up" 90 is raised so as to deflect the material onto a coiler 69 (see Figures 3 and 4). The coiler is driven so as to wind up the strip. At this time also, pinch rolls 68, which have been raised from the table to permit passage of the thick material, are lowered onto the strip to feed the strip to the coiler.

After all of the material has passed through the mill and before the trailing end goes through the pinch rolls 68, the coiler, the pinch rolls, and the mill are reversed. The pinch rolls 68 feed the strip back through the rolls of the mill 54, through the pinch rolls 68 on the other side of the mill, and into a coiler 69, also on the other side of the mill. This process is repeated until the material reaches the desired thinness.

The pinch rolls 68 are raised from the roll tables to a "high lift" position while thick material is being rolled, but they are lowered onto the strip to a "pinch" position when it is coiled and, according to the teaching of the patent, they remain down on the strip throughout the rest of the operation.

While Steckel's experimental mill demonstrated the feasibility of a reversing hot strip mill, many difficulties were encountered in its operation. It was difficult to cause the hot, flabby material being rolled to enter the rolls properly and, unless the material, particularly in the later stages of rolling, was entered with great care, cambered strip (strip longitudinally curved) resulted. There was trouble with the pinch rolls, which slit the strip instead of feeding it into the mill and which damaged the roll bearings in dropping from the high-lift position to the pinch position (P. App. 37a, 46a-47a). There was trouble in synchronizing the various operating parts of the mill (P. App. 36a) and considerable trouble in handling the hot, flabby strip. There were days in the four years of experiments when no slabs could be rolled successfully and they were indeed fortunate if, out of six or eight slabs, they successfully rolled one down to .100" (P. App. 36a).

The two patents with which this petition is concerned are directed to improvements which Mr. Montgomery invented during the long experimental period to solve the difficulties just listed.

Referring first to the '107 patent (P. App. 113a) and the one claim of that patent here involved (Claim 6), it is directed to a method of operation which eliminated the problem of camber or longitudinal curvature in the strip. The particular operation claimed is one in which the strip is passed back and forth between the reducing rolls, coiled on one side and uncoiled on the other and includes the steps of passing an end of the breakdown or strip entirely through the rolls, frictionally gripping the end of the strip to feed it back through the rolls and freeing the portion of the strip between the mill and the points of coiling so as to avoid any pinching action between these points, and, finally, *uniformly* tensioning the portion of the strip between the mill and the points of coiling.

The claims of the Montgomery '122 patent here involved are directed to a reversing hot mill with pinch rolls on at least one side of the mill and mechanism for operating the pinch rolls whereby they can be shifted into three separate positions, *i.e.*, a pinch position, a low-lift position, and a high-lift position. The pinch rolls in Steckel's experimental mill had only two positions, a pinch position and a high-lift position.

The additional low-lift position, conceived by Montgomery, gave the pinch rolls entirely new functions and the claims here involved are directed to mechanism which Montgomery developed whereby the pinch rolls could

be moved so as to carry out these new functions. Thus, during the rolling, the pinch rolls, according to Montgomery, are raised from the pinch position to a low-lift position so as to free the strip and so that the coilers and uncoilers can be used to provide uniform tension on the strip (P. App. 41a-42a; 56a; P. Supp. App. 15a-16a). At the end of each pass, the pinch rolls are lowered from the low-lift position to the pinch position to act as a brake on the strip and prevent the trailing end of the strip from going into the coiler furnace (R. 493-94); and, at the beginning of each pass, they are used for feeding.

Originally the "low-lift" position was designed to prevent damage to the strip and to the pinch rolls when the pinch rolls were dropped onto the strip from the high-lift position, but it was found "to our great surprise" (App. 77a-78a) that, when in the low-lift position, the pinch rolls performed several functions entirely new to pinch rolls as known in the art and new to pinch rolls as shown in the Steckel '214 and Keeney and Ferm patents. When in this position, the pinch rolls provide a vertical guiding action, holding the strip down inside side guides and thereby keep the strip under the control of the side guides, which, in turn, assist in preventing cambering (P. App. 52a-54a). The pinch rolls also minimize damage to the strip in the event that the strip strikes the side guides (R. App. 61b). They provide a lateral guiding action and limit sidewise movement of the strip (P. App. 40a-41a). They assist in maintaining uniformity of tension (P. App. 43a-44a, 54a-55a, 71a). They keep any looping of the strip away from the coilers (R. App. 21b-22b; P. App. 53a-55a). Thus, if a loop is formed on the strip on the exit side of the mill

because the mill is momentarily running faster than the winding coiler, the pinch roll in the low-lift position on the exit side of the mill keeps the loop between the mill and the pinch roll and prevents it from going over to the coiler where it would interfere with the reeling of the strip on the coiler (R. App. 21b-22b; P. Supp. App. 66a-67a). Finally, the pinch rolls in the low-lift position allow the strip to be raised from the table rolls and still be kept down within the side guides (P. App. 54a-55a).

The construction of the original Crucible mill is most readily seen in Exhibit P-16-3 (P. App. 135a) and the operation of the pinch rolls on the original mill is shown in Exhibit P-16-7 (P. App. 143a) in which the three different positions of the pinch rolls are illustrated.

In October and November of 1951, Crucible made two minor modifications in the mill which it contends took the mill outside the scope of the license agreement and avoided infringement after the agreement was canceled. The changes are best shown in Exhibit P-16-8 (P. App. 145a). Crucible's first modification was to change the drive for the "deflector roll" which is just below and slightly to the left of the coiler furnace wall. Originally, this deflector roll which guides the strip from the coiler down to the pinch rolls was driven continuously by a motor. Crucible's modification consisted in disconnecting this motor drive whenever the strip engaged the deflector roll so that it was then driven only by engagement with the moving strip.

The second change consisted in taking from the pinch roll assembly the intermediate or "low-lift position" and adding to the assembly an "auxiliary roll" which was brought down against the strip at the same

time that the old pinch roll assembly was put into the low-lift position. The action of the auxiliary roll is shown in Exhibit P-16-10 (P. App. 149a), in which the two positions of the auxiliary roll are illustrated, *i.e.*, a "low-lift position" when it engages the strip during coiling rolling and a "high-lift position" when it does not engage the strip.

The modifications just discussed had no effect whatever on the operation of the mill. The striking similarity between the modified Crucible mill and the mill shown in the two Montgomery patents is shown in the chart opposite this page, which is based on the testimony of Crucible's expert witness (P. Supp. App. 36a-47a, 53a-57a).

C. As to Questions I and II.

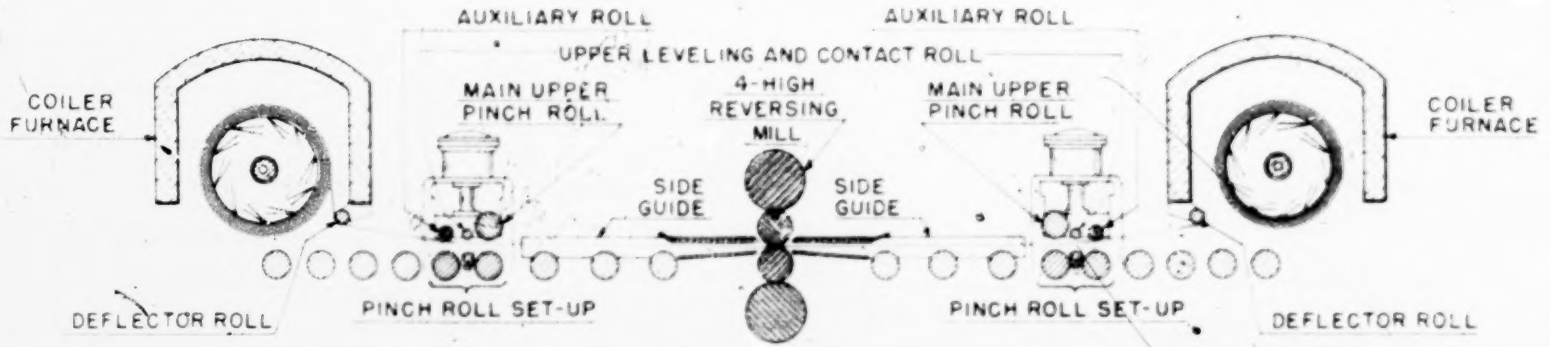
THE '107 PATENT.

The one claim in issue (Claim 6) of the '107 patent is directed to the operation of a reversing hot mill in which the portions of the strip between the reducing rolls in the mill and the coilers are freed and uniformly tensioned. The purpose of this operation is to avoid camber or sidewise curvature in the strip. Crucible contended that in its modified mill the strip was not freed between the mill and the coilers because the strip contacted two undriven rolls, the deflector roll at the mouth of the coiler furnace and the auxiliary roll which Crucible installed to take the place of the pinch rolls used on the original mill when in the low-lift position.

The District Court held (P. App. 240a-241a) that the contact of the strip with these undriven rolls had no effect on the operation of the mill and that, in Crucible's modified mill, the strip was freed and was

COMPARISON OF CRUCIBLE'S MODIFIED MILL AND THE MILLS OF MONTGOMERY '122 & '107

MONTGOMERY MILLS '122 & '107



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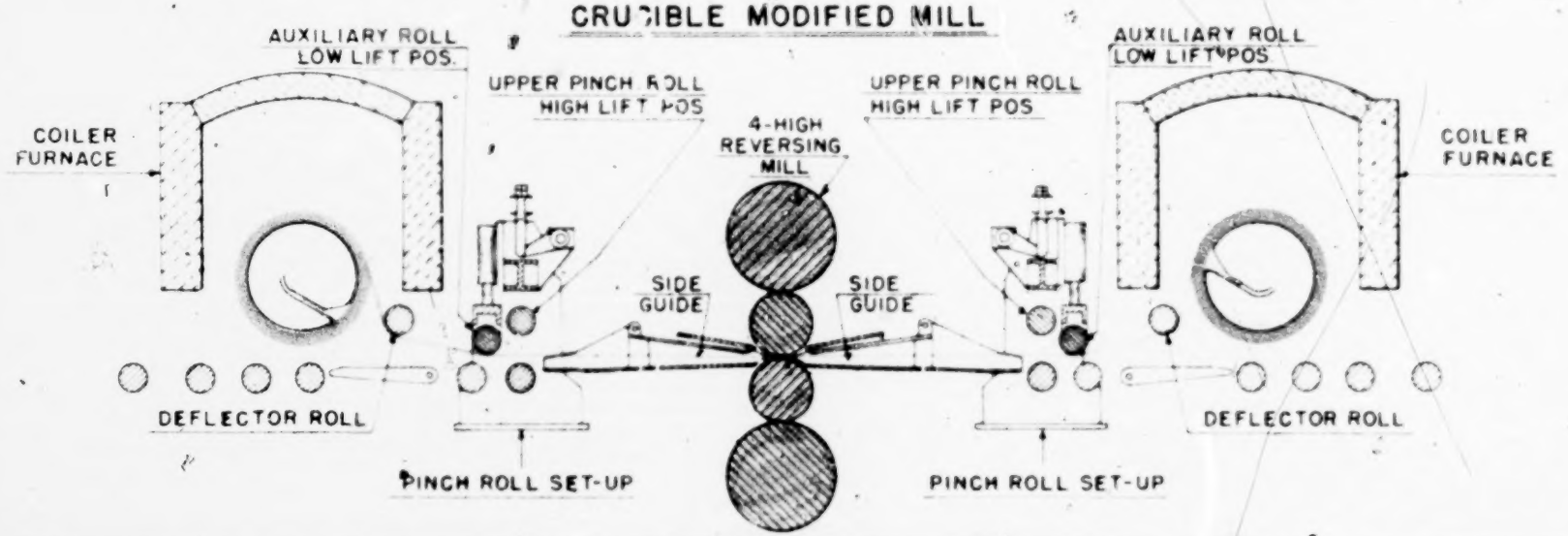

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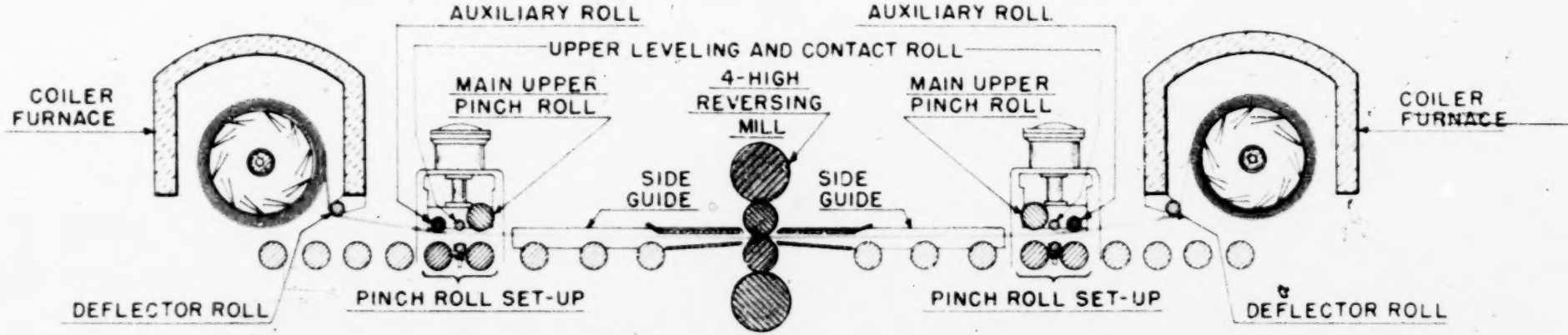
MONTGOMERY MILLS '122 & '107



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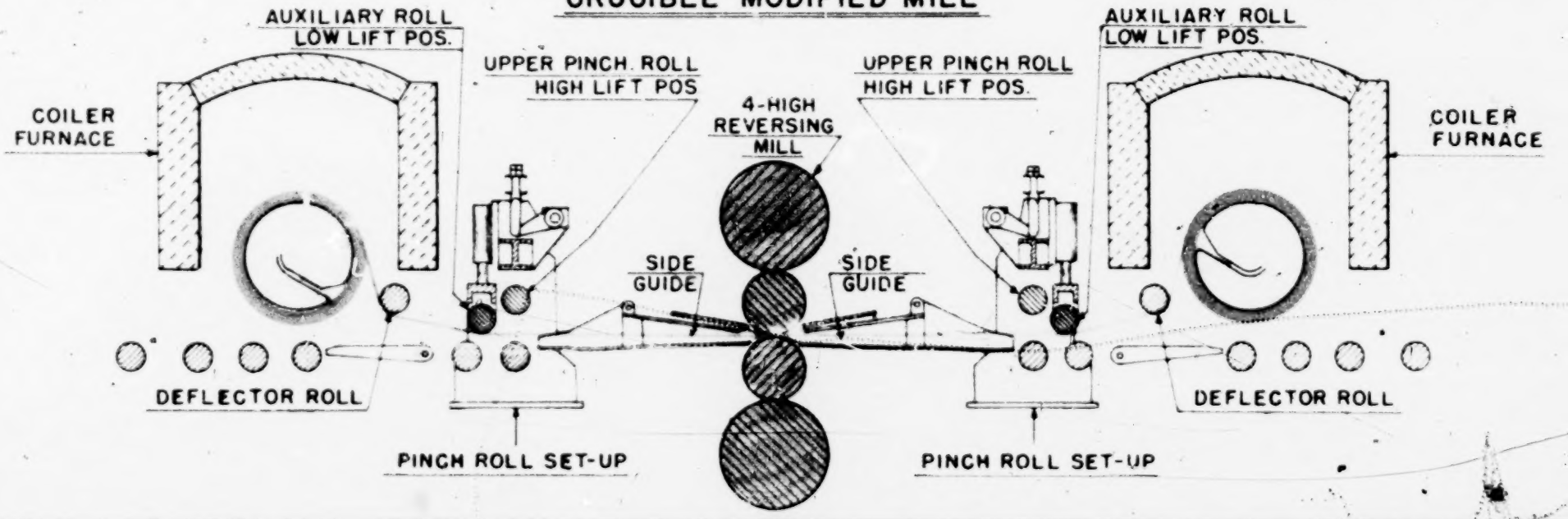

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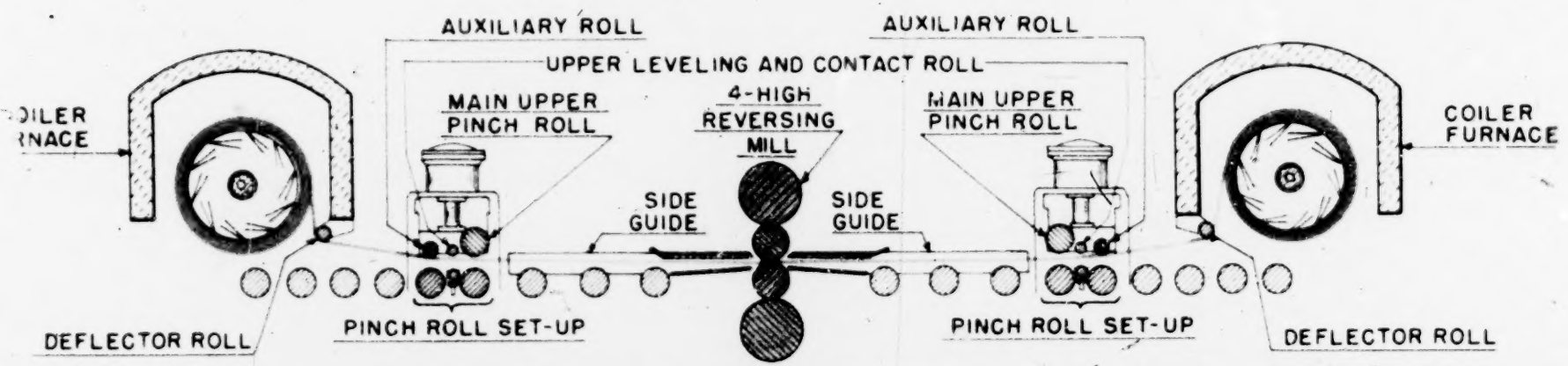

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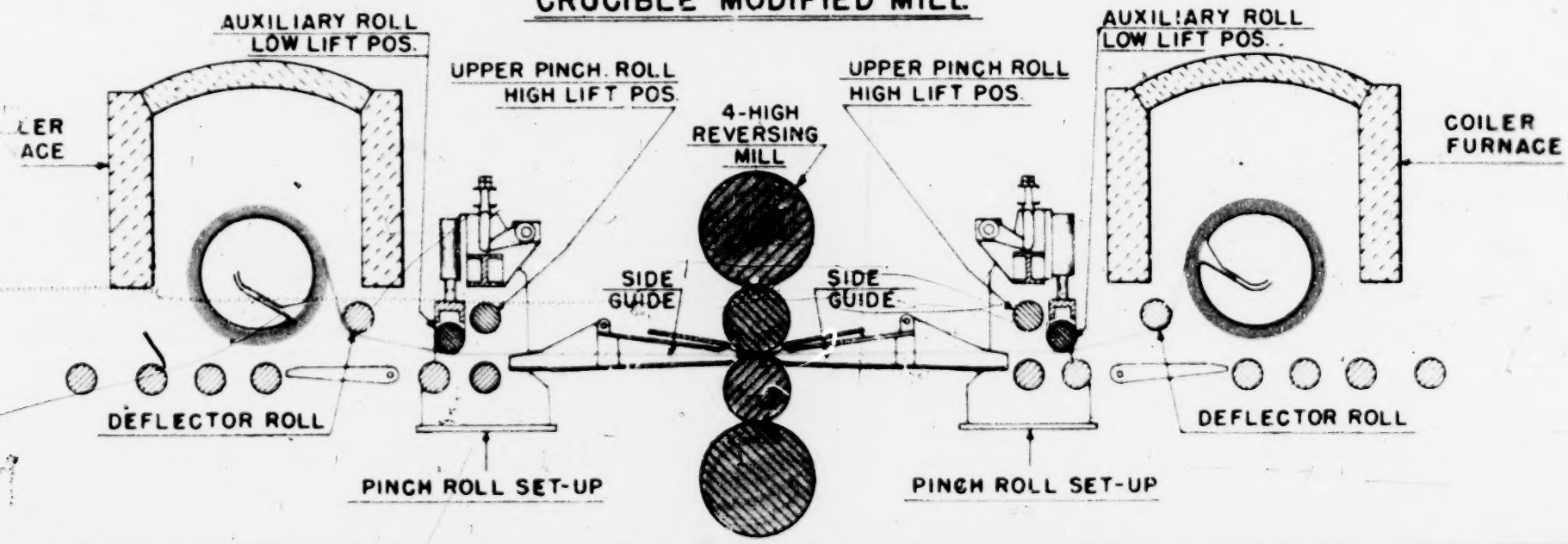

uniformly tensioned, as required by Claim 6. In so holding, the District Court relied on the testimony of expert witnesses for both parties. For Cold Metal, the witnesses were Freed (P. Supp. App. 15a-16a; P. App. 49a-51a) and Sachs (P. Supp. App. 23a-24a; P. App. 56a, 72a). Crucible's expert testified to the same effect (P. Supp. App. 53a-54a, 57a-59a).

Crucible, in its brief entitled "Brief for Defendant as Appellant and Appellee" stated that (p. 61):

> "* * * as a practical matter the tension in the Crucible strip was substantially uniform notwithstanding its contact with two undriven rolls on each side of the mill."

Nevertheless, the Court of Appeals held that Claim 6 did not cover the modified mill, saying (App., *infra*, p. 18a):

> "* * * the strip in the Crucible mill is not uniformly tensioned between the mill rolls and the coiler as claim 6 teaches."

All the testimony in this case was given by expert witnesses for both parties. Rule 52(a) of the Federal Rules of Civil Procedure, which provides:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

is, therefore, particularly applicable, as this Court has held: *Graver Tank & Mfg. Co., Inc. et al. v. Linde Air Products Co.*, (1949) 336 U. S. 271, 274-75; 339 U.S. 605, 609-10.

It is apparent from the decision of the Court below that it completely disregarded Rule 52(a) and the hold-

ing of this Court in the case just cited. It did not review the record to determine whether the holding of the District Court was "clearly erroneous" or whether the findings of the District Court were supported by substantial evidence. It simply proceeded to decide the case *de novo* and contrary to the evidence. There is substantial evidence to support the District Court's finding. Indeed, the finding of the Court of Appeals is *contrary to the entire record*. Clearly, the Court below did not follow Rule 52(a), as interpreted by this Court, and its decision on this point should be set aside.*

THE '122 PATENT.

As explained (*supra*, pp. 9-11), the claims of the '122 patent relate to the mechanism for operating the pinch rolls and are based on Montgomery's concept of providing the pinch rolls with an intermediate or "low-lift" position which is maintained while the strip is being rolled and coiled. New functions and advantages flowing from this arrangement of the pinch rolls were expressly found by the District Court (P. App. 244a-245a) and, therefore, it held the claims valid (P. App. 244a).

The District Court also held that Claims 6, 18 and 19 covered Crucible's modified mill, saying that the elimination of the low-lift position from the pinch rolls and the addition of an auxiliary roll to carry out the function formerly performed by the pinch rolls in the low-lift position "made no operational difference" and that the mill infringed after the cancellation of the license (P. App. 240a).

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* This issue—whether Claim 6 covers Crucible's modified operations—is of great importance, irrespective of validity, because of the contract issues involved.

The Court of Appeals rejected the District Court's findings of new functions and advantages arising out of the new low-lift position which Montgomery gave to the pinch rolls (P. App. 244a-245a), despite the fact that those findings are based squarely upon undisputed testimony of experts (P. App. 40a-44a, 53a-56a, 71a; P. Supp. App. 15a-16a, 66a-67a; R. App. 21b-22b, 61b.) The Court of Appeals also rejected the findings of the District Court, based squarely upon the testimony of the experts for both parties (*infra*, p. 16), as to Montgomery's teachings as to the operation of the mill described in the '122 patent. The Court below, in complete disregard of *all the evidence* and the District Court's findings, proceeded to chart a novel, erroneous course on which it based its conclusions that the '122 patent did not cover the modified licensed mill, that the patent was invalid and that it was not infringed in the post license period. It based those holdings on its novel view that the new functions of the pinch rolls when in low-lift position were not performed by the Montgomery pinch roll assembly and were contrary to Montgomery's teaching (App., *infra*, 9a-10a).

The Court below relied on a few phrases taken out of context from the Montgomery specification. The difference between the holdings of the District Court and the Court below lies entirely in the fact that the District Court followed the testimony of expert witnesses *for both parties*, whereas the Court below completely ignored the District Court's findings and the testimony. The issue was whether the Montgomery patent taught that the pinch rolls engaged the strip and held it down within side guides when the pinch rolls

were in a low-lift position. Cold Metal's expert testified that the patent did teach an arrangement in which the pinch rolls, when in a low-lift position, did hold down the strip (P. App. 50a-51a) and Crucible's expert witness likewise so testified (P. Supp. App. 44a-47a, 51a-52a; P. App. 40a-42a; R. App. 70b-71b). This is the arrangement shown in the chart appearing opposite page 12. The showing of the chart was completely rejected by the Court below although based squarely on the testimony of *Crucible's* expert.

The Court below completely ignored the testimony just mentioned and the findings of the District Court in complete violation of Rule 52(a). The Court below also ignored the fundamental rule of patent law, as enounced by this Court, that a patent is directed to those skilled in the art. This point is discussed under Question III.

The fundamentally erroneous view of the Court below, in regard to its function, is apparent from the face of its opinion. It said (App., *infra*, 6a):

> "The first question for our consideration on these appeals is whether the district court erred in holding the claims in suit of Patent No. 2,072,122 valid and infringed * * *."

The question before the Court below was not whether the District Court "erred", but whether the District Court's holdings were, as stated by this Court in *Graver Tank & Mfg. Co., Inc., et al. v. Linde Air Products Co.*, (1949) 336 U. S. 271, 274-75, "clearly erroneous" and not "supported by substantial evidence." The Court below, as appears from its opinion, did not pass on these questions. It did not even function as a

trial court for it ignored the evidence given by experts for both parties. Apparently, it is of the opinion that neither Rule 52(a) nor the fundamental rule that a decision should be based on the evidence applies to suits involving questions of the validity and infringement of patents. It should be set straight on such erroneous beliefs.

The action of the Court below, in deciding this case contrary to *all* the evidence and the findings by the District Court, is such a departure from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision. This is not a case of weighing conflicting testimony. It is a case of *ignoring* all the testimony and an express admission of one of the parties. Nor is there any question as to the application of the proper standard of invention. There are only plain questions of fact as to the operation of a rolling mill and the disclosure of a patent. On these questions, the Court below substituted its own judgment for the undisputed testimony of workers skilled in the rolling art. Such action calls for an exercise of this Court's power of supervision.

D. As to Question III.

As explained, *supra*, page 15, the Court below, in holding Claims 6, 18, and 19 of the '122 patent invalid and not infringed, substituted its own construction of the disclosure of the patent for the unanimous opinion of the experts for both parties as to what the patent taught them, the question being whether Montgomery, in this patent, taught that the pinch roll assembly, when in the low-lift position, remained in contact with the strip. In so doing, the Court below decided this case contrary to applicable decisions of this Court, all of which hold that the disclosure of a patent is directed to those skilled in the art to which the patent pertains. See:

The Telephone Cases, (1888) 126 U. S. 1, 536;
Seabury v. Am Ende, (1894) 152 U. S. 561, 567;
Carnegie Steel Company v. Cambria Iron Company, (1902) 185 U. S. 403, 437; and
Minerals Separation, Limited, et al. v. Hyde, (1916) 242 U. S. 261, 270-71.

The *Carnegie Steel* case, *supra*, is peculiarly applicable to the case at bar. In sustaining a patent to a method of mixing molten pig metal, this Court stated (p. 437):

> "The specification of the patent is not addressed to lawyers, or even to the public generally, but to the manufacturers of steel. * * *"

In the present case, we are concerned with the hot rolling of steel and we have the unanimous testimony of experts in the rolling art as to the teaching of the Montgomery patent. In refusing to follow the testimony of the experts, the Court below acted contrary to all of the applicable decisions of this Court.

REASONS FOR GRANTING THE WRIT.

1. The question whether Rule 52(a) of the Federal Rules of Civil Procedure is applicable to appeals in patent cases and, if so, the extent to which it applies should be finally decided by this Court. After this Court's decision in *Graver Tank & Mfg. Co., Inc. et al. v. Linde Air Products Co.*, (1949) 336 U. S. 271, it seemed clear that the rule did apply to appeals in patent cases. However, this Court's decision in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, (1950) 340 U. S. 147, created doubt in the Courts of Appeals for the different circuits. For an expression of this doubt, see *O'Brien v. O'Brien*, (7 Cir., 1953) 202 F. 2d 254. While expressing doubt, the Court of Appeals concluded that Rule 52(a) was applicable to appeals in patent cases, saying (p. 256):

> "Whether this is any indication that the Supreme Court has or is about to retract or modify its emphatic pronouncement in the Graver case on the weight to be attached to the findings in a patent case, we do not know. However, until the Supreme Court has expressly done so we think this court should evaluate the findings in a patent case the same as in any other."

The Court of Appeals for the Seventh Circuit has adhered to this rule. See *The University of Illinois Foundation v. Block Drug Co. et al.*, (7 Cir., 1957) 241 F. 2d 6, wherein the Court stated (p. 10):

> "Thus, in reality the issues here are not merely those of invention and infringement but whether this Court can say that the findings of the District Court on these issues are clearly erroneous."

In contrast to this proper statement of the issues before a Court of Appeals in a patent case, the Court below stated (App., *infra*, p. 6a):

> "The first question for our consideration on these appeals is whether the district court erred in holding * * *."

From this statement, the only conclusion which can be drawn is that the Court below believed that the case was to be considered *de novo* by it and completely unrestrained by Rule 52(a) of the Federal Rules of Civil Procedure. There is thus a conflict in decision between Courts of Appeals on an important question of federal procedure, and this conflict should be settled by this Court.

2. The decision of the Court below on the issues discussed above is squarely in conflict with this Court's decision in the *Graver* case, *supra* pp. 13, 16, 19.

3. The action of the Court below in deciding this case contrary to all of the evidence is such a departure from the accepted course of judicial proceedings as to call for this Court's supervision.

4. The decision of the Court below is in conflict with prior decisions of this Court holding that the specification of a patent is directed to those skilled in the art.

CONCLUSION.

We respectfully submit that the decision of the Court below is clearly erroneous and that this petition should be granted.

Respectfully submitted,

WILLIAM H. WEBB
Counsel for Petitioner

MORTON BURDEN, JR.
Of Counsel

December 23, 1957

APPENDIX

OPINION OF THE COURT OF APPEALS

Decided Aug. 9, 1957.

Rehearing Denied Sept. 25, 1957.

Before MARIS, STALEY and HASTIE, Circuit Judges.

MARIS, Circuit Judge.

These are cross appeals by the plaintiff, Cold Metal Products Company and the defendant, Crucible Steel Company of America, from a judgment entered in the District Court for the District of New Jersey. They involve questions as to the validity of certain patents owned by Cold Metal, as to the infringement of the patents by Crucible after April 1, 1953, when a license agreement between the parties terminated, and as to Cold Metal's right to royalties from Crucible under the license agreement for the period November 20, 1951 to April 1, 1953. The patents in suit, Montgomery No. 2,072,122, Montgomery No. 2,087,065 and Montgomery No. 2,214,107, relate to improvements in apparatus and methods for rolling heated metal ingots into long thin strips in a reversing hot rolling mill.

One method of performing this operation is to use a continuous hot mill consisting of a roughing mill plus a finishing mill, the latter consisting of a number of mill stands set in a row, one after the other. In the operation of such a mill the original ingot is reduced in the roughing portion of the mill to the dimensions of a slab or "breakdown", which is then reduced to strip of the desired thickness by a single continuous pass through the row of mill stands comprising the finishing portion of the mill. The mill stands comprising the finishing por-

tion of such a mill have conventionally been 4-high mills equipped with antifriction bearings.

The other method of performing the operation is by the use of a reversing hot mill. The roughing portion of such a mill is not different from that of a continuous mill but the finishing operation, instead of being conducted by passing the material once through a succession of mill stands as in a continuous mill, is conducted by passing the strip back and forth through a single finishing mill stand, the rolls of which are brought closer and closer together for each successive pass until the strip has been reduced to the desired thickness. The mill stand used in such a reversing hot mill ordinarily is the same sort of 4-high mill with antifriction bearings as is used in the finishing portion of a continuous mill. On each side of the finishing mill stand are a roll table over which the strip passes, a pair of pinch rolls for gripping and moving the strip, side guides for confining it in its path, a deflector to direct it into the coiler furnace, and a coiler furnace and a coiling reel therein upon which the strip is wound as it is passed through the mill and kept heated for its next pass through the mill in the reverse direction. The Steckel Patent No. 1,857,670, the Keeney & Ferm Patent No. 1,918,968 and the Steckel Patent No. 1,977,214, all owned by Cold Metal and all now expired, cover basic features of reversing hot mills such as we have described. The three subsequently issued Montgomery patents in suit cover improvements in the apparatus and process of such mills.

Reversing hot mills do not produce as fine a product as is produced by continuous mills and their produc-

tivity necessarily is not as high but they do have the advantage of costing very much less than continuous mills. This advantage apparently appealed to Crucible and on September 30, 1946 it entered into a license agreement with Cold Metal covering Cold Metal's reversing hot mill patents, including, inter alia, the six patents above mentioned. Under this license agreement Crucible installed in its plant at Midland, Pennsylvania, a reversing hot rolling mill which it began to operate commercially on April 1, 1949. Its installation comprised a single stand universal roughing mill for rough rolling ingots into rectangular slabs and into relatively long and thin breakdowns and a single stand reversing hot finishing mill for hot rolling the breakdowns into continuous strip. Roll tables were installed in advance of the universal mill, between the universal mill and the reversing mill, and extended beyond the reversing mill for conveying ingots, slabs, breakdowns and strip into, through and out of the mill.

The license agreement called for the payment of royalties at a fixed rate during the lifetime of the three dominating Steckel and Keeney & Ferm patents, the last of which expired on October 16, 1951, and at half the original rate after that date, provided that Crucible's mill was thereafter covered by any claim of any of the remaining unexpired patents included in the license. Termination of the agreement was permitted on April 1, 1953 and it was terminated by Crucible on that date. Crucible paid Cold Metal royalties amounting to $655,189.54 until November 30, 1951, but none after that date, contending that its mill, as modified in October and November, 1951 was not covered by any claim of the licensed patents which still remained unexpired.

Cold Metal brought suit on December 18, 1952 in the District Court for the District of New Jersey for royalties allegedly due under the license agreement for the use of the mill and equipment for the period November 30, 1951 to April 1, 1953 and for royalties in addition to those already paid for the period April 1, 1949 to November 30, 1951. On July 2, 1954 it instituted an action in the District Court for the Western District of Pennsylvania against Crucible for infringement of the patents here in suit subsequent to April 1, 1953, the termination date of the license agreement. Crucible filed a motion in the District Court in New Jersey for leave to file a supplemental counterclaim seeking a declaratory judgment that Cold Metal's three Montgomery patents are invalid and noninfringed and asked the court to enjoin the prosecution of the Pennsylvania patent infringement suit. Cold Metal moved, pursuant to section 1404(a) of title 28 United States Code, for an order transferring the New Jersey action to the Western District of Pennsylvania. Crucible's motions were granted and Cold Metal's motion was denied. 126 F. Supp. 546.

In its supplemental counterclaim Crucible sought a declaratory judgment that the three Montgomery patents in suit are invalid and not infringed and also asked the court to enjoin any further suits under these patents. Cold Metal, in a counterclaim annexed to its reply to Crucible's supplemental counterclaim, charged infringement of its patents by the unauthorized use by Crucible of its mill after the termination of the license agreement, for which Cold Metal sought an accounting of profits and damages. In defense to this claim Crucible attacked the validity of the patents and asserted that the alterations in its mill and in the process employed

in its operation which it had made in October and November, 1951 and which were completed on November 19, 1951 had taken its mill out from under the claims of Cold Metal's unexpired patents.

Upon the trial of the present action in the District of New Jersey the district court found that Cold Metal was entitled to recover additional royalties under the license agreement for the period April 1, 1949 through November 19, 1951 and entered judgment in favor of Cold Metal in the amount of $146,210.38 together with interest amounting to $53,359.89, a total of $199,570.27. This amount was subsequently paid by Crucible and is not involved in the present appeals. The district court also found that the changes made by Crucible in its mill in October and November, 1951 did not relieve it from liability for royalties under the license agreement and that Cold Metal was entitled to royalties from November 20, 1951 to April 1, 1953, the termination date of the agreement, and entered judgment on this score in favor of Cold Metal in the amount of $334,942.97, together with interest of $88,259.24, a total of $423,201.31. Certain allowances were made to Crucible for royalty overpayments.

The district court held that claims 6, 10, 18 and 19 of Montgomery Patent No. 2,072,122 were valid and had been infringed by Crucible from April 1, 1953 to the date of the patent's expiration, March 2, 1954. The court accordingly adjudged Cold Metal to be entitled to recover damages for Crucible's infringement of that patent and referred to a master the determination of the amount of such damages. The court held that claims 1, 2, 3, 4 and 5 of Montgomery Patent No. 2,087,065 and

claims 4 and 6 of Montgomery Patent No. 2,214,107 were invalid. 147 F.Supp. 25. These cross appeals by Cold Metal and Crucible followed.

The first question for our consideration on these appeals is whether the district court erred in holding the claims in suit of Patent No. 2,072,122 valid and infringed and the claims in suit of Patents Nos. 2,087,065 and 2,214,107 invalid. In considering these questions we must bear in mind that these are not basic patents but merely claim improvements in the process and apparatus of the reversing hot rolling mill which was disclosed and the basic essentials of which were covered by the Steckel and Keeney & Ferm patents.[1] Those basic patents having expired, Crucible and all the world became free to use that mill. The three patents in suit must, therefore, disclose patentable improvements over Steckel and Keeney & Ferm in order to be valid. Moreover in order to justify a finding of infringement it must appear that these improvements on the prior art were employed in the Crucible mill after the changes therein were completed on November 19, 1951.

We consider first Montgomery Patent No. 2,072,122. Claims 6, 18 and 19 of this patent[2] relate to the

[1] Certain claims of the Keeney & Ferm Patent No. 1,918,968 and the Steckel Patent No. 1,977,214 have been held invalid in Cold Metal Products Co. v. Newport Steel Corp., 6 Cir., 1955, 226 F.2d 19.

[2] "6. In a rolling mill including a pair of housings and work rolls journaled therein, pinch rolls on one side of the mill, and means for raising one of the pinch rolls through a short distance, and independent means for raising the upper pinch rolls through a greater distance.

"18. In a rolling mill, a pair of housings having work rolls journaled therein, pinch rolls on at least one side of

pinch rolls employed in a reversing mill to engage the strip and feed it to the mill rolls or the coilers. Keeney & Ferm employed pinch rolls near the entrance to each of the coiling furnaces, which were held in engagement with the strip by adjustable springs and were provided with a motor drive to enable them to be used to feed strip toward the coiler or the mill rolls as the case might be. Their drives included magnetic clutches so that the drives would be disconnected and the rolls allowed to act as "idle guide rollers" when not required for feeding purposes. Steckel No. 1,977,214 had pinch rolls which, though originally intended to be used to apply tension to the strip as well as to feed it to the mill and coilers, were "arranged to be raised and lowered as desired". The raising and lowering was accomplished by controlling the supply of air to cylinders in which were located vertically moving pistons connected to the housing in which the pinch rolls were mounted. Since this was a single stand mill the upper limit of travel of the upper pinch roll had to be high enough to permit the passage of the thickest material to be passed through the mill.

It appears that when the raised pinch roll was dropped from such a height it came down with such

the mill for engaging material being worked in the mill, means for retracting one of said pinch rolls when unused for a substantial period, and independent means for temporarily retracting one of said rolls.

"19. The combination with a rolling mill and a roll table for advancing work thereto, of pinch rolls on one side of the mill, one of said pinch rolls being retractible, and means for retracting said roll including fluid pressure-operated cylinders and pistons, one of which has a short stroke for temporarily retracting the roll and the other having a longer stroke for retracting the roll when unused for substantial periods."

force as to involve danger of marring the strip and damaging the equipment. The evidence establishes that it was to remedy this situation that the improvement of the claims now under discussion of Patent No. 2,072,122 was directed. This was to add an extra pair of cylinders of shorter stroke so that the upper pinch rolls could be raised only a short distance off the strip by using these new cylinders or the original longer distance by using the original set of cylinders. The language of claims 18 and 19 suggests that the purpose is to use the low lift cylinders for temporarily retracting the upper pinch rolls and the high lift cylinders for retracting them for longer periods. We are satisfied that these claims disclose an obvious expedient, the addition to the means employed by Stegkel of another means of the same type to perform the same function of lifting the upper pinch rolls, but to a different and less elevated position. This was mere aggregation and in any event did not rise to the dignity of invention.

Cold Metal, however, argues and the district court held that the upper pinch rolls in the new low lift position perform new and useful functions not disclosed or claimed in the patent. It asserts that in this position they provide a vertical guiding action, holding the strip down inside the side guides and thereby keeping the strip under the control of the side guides and assisting in preventing cambering, they minimize damage to the strip in the event that it strikes the side guides, they provide a lateral guiding action and limit sidewise movement of the strip, they assist in maintaining uniformity of tension, they keep any looping of the strip away from the coilers, and finally they allow the strip to be raised from

the table rolls and still be kept down within the side guides.

The difficulty with this argument is that this use of the upper pinch rolls in the low lift position as guide and hold-down rolls is not taught by the patent but is in fact a departure from its teachings. For the specification of the patent refers to the pinch rolls when elevated to the low lift position as being "lifted off the strip", "lifted from the material" and "lifted out of the way when there is no further need for them." It is apparent that what Cold Metal is here asserting as covered by the claims of this patent is the procedure which Crucible employed in its licensed mill, not what the patent claimed. But the fact that Crucible prior to the changes completed on November 19, 1951 employed the upper pinch rolls in their low lift position for these purposes does not bring those functions within the scope of this patent. For as we have seen it was a departure from and not a use of the invention here claimed. Moreover the use of a roll as a guide in such a mill was fully disclosed in the prior art. Keeney & Ferm No. 1,918,968; Steckel No. 1,977,214. In any event at this stage of the art it was an obvious expedient to introduce such a roll where it was found to be needed. We conclude that the district court erred in holding claims 6, 18 and 19 of Patent No. 2,072,122 valid.

Little need be said with respect to the alleged infringement of these claims. Prior to November 20, 1951 Crucible admittedly used the double lift feature of the claims with respect to the pinch rolls of its mill. But by that date it had completed the removal of the additional short stroke cylinders from those rolls and had

installed wholly separate guide rolls on each side of the mill. These guide rolls undoubtedly performed the guiding functions which the upper pinch rolls in low lift position had theretofore performed in the Crucible mill. But, as we have seen, the performance of these functions by a guide roll such as Crucible installed was disclosed by the prior art while the performance of those functions by the pinch rolls was not taught by the patent, indeed was excluded by its teachings. And the apparatus actually disclosed in these claims of the patent, means for raising the pinch rolls through a short distance and independent means for raising them through a greater distance, was not used by Crucible after November 19, 1951. We conclude that the district court erred in holding that claims 6, 18 and 19 of Patent No. 2,072,122 were infringed by Crucible.

We turn then to the only other claim of Montgomery Patent No. 2,072,122 which is in suit, claim 10. This relates to the adjustable side guides on each side of the mill whose function is to guide the strip from the coiler to the mill rolls on the entering side of the mill and from the mill rolls to the coiler on the other side. Steckel No. 1,977,214 had taught that the guides should be positioned close to the sides of the strip on the entering side and should be farther apart on the other side. Their position was to be changed each time the direction of the strip through the mill was reversed. Montgomery taught that the guides should be adjusted on the delivery side of the mill so as not to be parallel but to form a tapered guiding throat and several of his claims are directed to this tapered feature. But since it was not followed by Crucible these claims are not here involved.

Claim 10 [3] is directed to the combination of a mill with a driving motor and a controller for the motor which also operates the means for shifting the adjustable side guides inwardly on the entrance side and outwardly on the exit side of the mill. The invention claimed is in the use of the single controller for the two purposes so that the position of the side guides will be automatically reversed when the direction of the mill is reversed. We cannot find invention in this combination. When it is desired to have two things happen simultaneously which are actuated electrically nothing is more obvious than to control them by the same switch. Claim 10 calls for no more than this. For Montgomery did not claim to invent the controller means or the idea that the guides should be adjusted each time the mill was reversed. The district court accordingly erred in holding claim 10 to be valid.

Nor do we think that the district court was right in holding that claim 10 was infringed. In the Crucible mill the teaching of claim 10 was originally followed. But in the summer of 1950 a new arrangement was made under which the side guides were caused to change their respective positions each time the mill motor circuit was opened to cause the mill to stop, the change in position being wholly independent of the direction in which the mill had been running or the direction in which it would next run. Whenever the mill stopped, whether

[3] "10. The combination with a rolling mill having a driving motor and a controller for the motor, of adjustable side guides on both sides of the mill, and means operated by said controller for shifting the guides inwardly on the entrance side of the mill and outwardly on the exit side of the mill."

by moving the motor controlier to the off position, by pushing the independent stop button with which the Crucible mill was also equipped or by the opening of the circuit breaker on overload, the side guides changed position. Thus it was the opening of the mill circuit from any cause, and not necessarily the movement of the motor controller, which caused the guides to change position. And even when the change of the side guides was actuated by the mill motor controller it was the action of the controller in stopping the mill which effected the change not its action in starting the mill in the opposite direction. We are satisfied that this changed procedure of the Crucible mill did not infringe claim 10 of Patent No. 2,072,122.

We consider next Montgomery Patent No. 2,087,065. This is a patent on a method of rolling metal strip in which the heated slab is first rolled sufficiently thin in a roughing mill for coiling and then in the same heat is fed to a reversing mill where it is subjected to successive passes to reduce it to the desired thinness, coiling it between passes in the reversing mill. All five claims of the patent are involved.[1] Claim 1 is the broad-

[1] "1. In a method of rolling metal strip, the steps consisting in supplying to a roughing mill a heated slab-like body which is too thick for coiling, rolling the body in the roughing mill until it is substantially thin enough to permit of coiling, but maintaining the thinned body in the flat state, and, in the same heat, feeding the thinned body to a reversing mill, subjecting it to successive passes therein to reduce it to a desired strip thickness, and coiling it between passes in the reversing mill.

"2. In a method of rolling metal strip, the steps consisting in supplying to a roughing mill a heated slab-like body which is too thick for coiling, rolling the body in the

est and the other four do not disclose any inventive differences over it. The district court did not err in

roughing mill until it is substantially thin enough to permit of coiling but maintaining the thinned body in the flat state, trueing the edges in said mill, and, in the same heat, feeding the thinned body to a reversing mill, subjecting it to successive passes therein to reduce it to a desired strip thickness, and coiling it between passes in the reversing mill.

"3. In a method of rolling metal strip, the steps consisting in supplying to a roughing mill a heated slab-like body which is too thick for coiling, rolling the body back and forth in the roughing mill until it is substantially thin enough to permit of coiling, but maintaining the thinned body in the flat state, and, in the same heat, feeding the thinned body to a reversing mill, subjecting it to successive passes therein to reduce it to a desired strip thickness, and coiling it between passes in the reversing mill.

"4. In a method of rolling metal strip, the steps consisting in supplying to a roughing mill a heated slab-like body which is too thick for coiling, rolling the body in the roughing mill until the body cools to a temperature below that at which free scale forms, and until it is substantially thin enough to permit of coiling, but maintaining the the thinned body in the flat state, and, in the same heat, feeding the thinned body to a reversing mill, subjecting it to successive passes therein to reduce it to a desired strip thickness, and coiling it between passes in the reversing mill.

"5. In a method of rolling metal strip, the steps consisting in supplying to a roughing mill a heated slab-like body which is too thick for coiling, rolling the body in the roughing mill until it is substantially thin enough to permit of coiling, but maintaining the thinned body in the flat state, and, in the same heat, feeding the thinned body to a reversing mill after cropping at least one end of the thinned body to facilitate its entry into said reversing mill, subjecting it to successive passes therein to reduce it to a desired strip thickness, and coiling it between passes in the reversing mill."

holding this patent invalid as being completely anticipated by the prior art.[5] The record established that it was usual to have a roughing mill operating in line with a continuous finishing mill and there is no difference in principle in using a roughing mill in conjunction with a reversing finishing mill as distinguished from a continuous finishing mill. Indeed that very combination is suggested in Keeney & Ferm and Steckel No. 1,977,214. And in the prior patent to Cushwa, No. 904,605, the conduct of such a continuous operation in the same heat is fully disclosed.

The last of the patents to be considered is Montgomery No. 2,214,107. Two claims of this patent are in issue, claims 4 and 6, which relate to methods of operating a reversing hot mill designed to permit the strip to be tensioned uniformly between the mill and the coiler. The district court held both claims to be invalid. Its holding of invalidity as to claim 4 is not seriously questioned in this court. We will, therefore, confine our consideration to claim 6 which describes the process, after the breakdown has passed through the rolls of a reversing mill, of feeding its end back into the mill

[5] This patent has been held invalid by the Court of Appeals for the Sixth Circuit in Cold Metal Products Co. v. Newport Steel Co., 1955, 226 F.2d 19.

"6. In a method of rolling strip, the steps, including passing a breakdown heated to plastic condition, back and forth between reducing rolls, uncoiling it on one side and coiling it on the opposite side of the rolls, passing an end of the breakdown entirely through the rolls, frictionally gripping said end to feed it back through the rolls, freeing that portion of the breakdown between the mill and the point of coiling, and tensioning such portion uniformly throughout."

rolls by frictionally gripping it with the pinch rolls and after it is engaged by the mill rolls freeing the part of the breakdown between the mill rolls and the point of coiling and tensioning that part uniformly throughout.

The district court was right in holding that claim 6 is invalid. Uniformly tensioning the strip between the mill rolls and the coiler is disclosed in Steckel No. 1,857,670. Tension on the strip is also employed in Keeney & Ferm and Steckel No. 1,977,214. In the latter two patents pinch rolls are interposed between the mill rolls and the coilers. In Keeney & Ferm these are so arranged as to maintain a continuous frictional grip upon the strip. But in Steckel provision is made for lifting the upper pinch rolls off the strip. Thus all of the steps of claim 6 are disclosed in the prior art. It was an obvious expedient to lift the gripping pinch roll off the strip after its engagement by the mill rolls in order to achieve the uniform tension in the strip which Steckel No. 1,977,214 had taught was needed to prevent cambering. To lift the retractible upper pinch rolls off the strip during times when their use was found to be unnecessary or detrimental to the operation was not invention.

It remains to consider Crucible's contention that the district court erred in holding that it was required to pay royalties under the license agreement for the period during which that agreement was in force after November 19, 1951. Such payment was required under the terms of the agreement if Crucible's mill or its operation was covered by one or more claims of the licensed patents. By November 19, 1951 the basic patents, Steckel No. 1,857,670, Keeney & Ferm No. 1,918,968

and Steckel No. 1,977,214 had all expired. But Cold Metal contends that the claims in suit of the three improvement patents involved in this case all covered Crucible's mill or its operation as it existed and was operated after the changes made on and prior to November 19, 1951. If any one or more of these does so Crucible concedes that it is required to pay royalty under the agreement. But it vigorously urges that none of the claims in suit covers its mills or operations. We turn then to consider this question.

So far as concerns the claims in suit of Montgomery Patent No. 2,072,122 our conclusion that these claims were not infringed because Crucible's mill and operations were not within their proper scope after the termination of the license agreement on April 1, 1953 is dispositive of the present question. For if the Crucible mill and operation did not infringe those claims the same mill and operation could not make Crucible liable to pay royalty under the license agreement by reason of the use of the patented invention. The issues in both situations are essentially the same. Hewitt v. American Telephone & Telegraph Co., D.C.N.Y. 1920, 272, F. 194, affirmed, 2 Cir., 1921, 272 F. 392; Cold Metal Process Co. v. United Engineering & Foundry Co., 3 Cir., 1956, 235 F.2d 224, 229.

Montgomery Patent No. 2,087,065 claims, as we have seen, a process involving a combination of a roughing mill and a reversing finishing mill in which the strip is passed from the roughing mill to the reversing mill in the same heat and then passed back and forth in the latter mill with coiling of the strip between the passes. Although the patent was invalid Crucible must pay

royalty under the agreement if its mill operation is covered by the claims of the patent. Nonetheless it is entitled to have the claims considered in the light of and their scope restricted by the prior art. Considered in that light the claims of this patent must be restricted for the present purpose to their exact disclosures. One of these is that the strip is coiled between every pass in the reversing mill. Indeed in this case Cold Metal is limited by file wrapper estoppel to that precise method in which the strip is coiled after every pass through the reversing mill and is never passed through that mill flat. Crucible, however, did not practice this precise process during the significant period. On the contrary it always passed the strip twice through the finishing mill flat before introducing it into one of the furnace coilers. Its operation was accordingly not covered by the claims of this patent.

Finally we consider claim 6 of Montgomery Patent No. 2,214,107,[7] which calls for a method of lifting the upper pinch rolls off the strip after it has been engaged by the mill rolls so as to provide uniform tension in the strip between the mill and the coiler. We are satisfied that Crucible did not in its mill operation follow the procedure of this claim but rather that of the prior art. For it interposed upon the strip the guide or hold-down roll which it installed when it removed from its mill the low lift pinch roll feature of Montgomery No. 2,072,122. And it also interposed upon the strip a guide roll at the furnace entrance. It was a part of the teaching of claim 4 of this patent, although not of claim 6, that a guide

[7] Cold Metal does not contend that Crucible's operation is covered by claim 4 of this patent.

roll should be driven "to prevent frictional drag on the breakdown." Since Crucible's rolls are undriven they necessarily exert some frictional drag upon the strip. As a consequence the strip in the Crucible mill is not uniformly tensioned between the mill rolls and the coiler as claim 6 teaches. It thus appears that Crucible did not practice the only novel feature of claim 6 of Patent No. 2,214,107.

To summarize our conclusions, the district court rightly held that the claims in issue of Montgomery Patents Nos. 2,087,065 and 2,214,107 are invalid, but the court erred in holding the claims in issue of Montgomery Patent No. 2,072,122 valid and infringed, in holding that the claims in issue of Patents Nos. 2,087,065 and 2,214,107 covered Crucible's modified mill and operations, and in awarding royalties for the period from November 20, 1951 to April 1, 1953, and damages for infringement of Patent No. 2,072,122 after that date.

Paragraphs 2, 5, 6, 7, 8, 9 and 10 of the judgment of the district court are involved in the appeals now before this court. Paragraphs 2, 5, 6 and 9 will be reversed, paragraph 10 will be vacated, paragraphs 7 and 8 will be affirmed and the cause will be remanded to the district court with directions to incorporate in the judgment a paragraph adjudging that claims 6, 10, 18, and 19 of U. S. Letters Patent No. 2,072,122 are invalid and an appropriate paragraph as to costs. Costs will be allowed to the defendant on each appeal.

JUDGMENT OF THE COURT OF APPEALS

ON APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF NEW JERSEY

Present: MARIS, STALEY and HASTIE, Circuit Judges.

JUDGMENT

This cause came on to be heard on the record from the United States District Court for the District of New Jersey and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that paragraphs 2, 5, 6 and 9 of the judgment of the District Court be, and they are hereby reversed; that paragraph 10 of the judgment be, and it is hereby vacated; that paragraphs 7 and 8 of the judgment be, and they are hereby affirmed; and the cause remanded to the District Court with directions to incorporate in the judgment a paragraph adjudging that claims 6, 10, 18 and 19 of U.S. Letters Patent No. 2,072,122 are invalid and an appropriate paragraph as to costs. Costs to defendant on each appeal.

Attest:
HARRIET G. HUMPHRYS
Chief Deputy Clerk

August 9, 1957

RULE 52 (a) OF THE FEDERAL RULES OF CIVIL PROCEDURE

Rule 52. Findings by the Court.

(a) EFFECT. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41 (b).